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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/628,225

07/29/2003

Olli Nuortila

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05/04/2007

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EXAMINER

SHIN, KYUNG H

ART UNIT

PAPER NUMBER

2143

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DELIVERY MODE

05/04/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/628,225

Applicant(s)

NUORTILA, OLLI

Examiner

Kyung H. Shin

Art Unit

2143

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☒ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 7/29/03.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

1. This action is responding to application filed on **7/29/2003**. Claims **1 - 12** are pending. Claims **1, 6, 10, 11** are independent.

Priority

2. Acknowledgment is made of applicant's claim for **foreign priority** based on an application filed in FINLAND on 2/1/2001. It is noted, however, that applicant has not filed a certified copy of the 20010194 application documents as required by 35 U.S.C. 119(b). Only a cover page of the certified copy of the foreign application filed with the Finnish Patent office was sent to PTO on 7/29/2003.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims **1 - 3, 5 - 12** are rejected under 35 U.S.C. 102(e) as being anticipated by **Fuisz et al.** (US Patent No. **6,389,455**).

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Regarding Claim 1, Fuisz discloses a method for keeping user's particular outgoing e-mail correspondence separate from user's other e-mail correspondence, characterized by the steps of: in the user's e-mail client program replacing in a particular outgoing e-mail message a recipient address set by the user with the address of a mediating server, moving the recipient address into another field of the e-mail message, sending the e-mail message to the mediating server, and in the mediating server moving in the e-mail message to be forwarded the recipient address from said another field into the recipient field, and placing the address used in said particular e-mail correspondence into the sender field of the e-mail message. (see Fuisz col. 1, lines 58-63: separate e-mail accounts; col. 5, lines 19-24: mediating server; col. 1, lines col. 2, lines 31-33: addressed to mediating server; col. 2, lines 33-35: move recipient address; col. 2, lines 38-40: send e-mail; col. 3, lines 35-40: replace recipient address; col. 6, lines 34-37: mail address in sender)

Regarding Claim 2, Fuisz discloses the method as in claim 1, characterized in that the recipient address is put into the recipient field of the message, additional information is added to the recipient address in the recipient field, which causes the recipient address to be ignored when the message is routed to the mediating server. (see Fuisz col. 2, lines 33-38: address field(s) ignored by mediating server)

Regarding Claim 3, Fuisz discloses the method as in claim 1, characterized in that when the user places a plurality of recipient addresses to the message all the recipient

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addresses are replaced with the address of the mediating server, all the recipient addresses placed to the message by the user are moved into other field or fields of the message than any of the recipient fields. (see Fuisz col. 2, lines 33-35: col. 4, lines 26-31: move recipient in other fields)

Regarding Claim 5, Fuisz discloses the as in claim 1, characterized in that replacing and moving of the address are made automatically by means of a particular message writing form that contains the address of the mediating server not visible to the user. (see Fuisz col. 7, lines 18-29: mail message, non-internet services, auto format database conversion)

Regarding Claim 6, Fuisz discloses a method for keeping user's incoming particular e-mail correspondence separate from user's other e-mail correspondence, characterized by the steps of: routing an e-mail mail addressed to the user's particular e-mail address is to a mediating server, moving in the mediating server the original sender address into other field than the address field, replacing the address in the recipient field with another address specified by the user, placing the address of the mediating server into the sender field, and retransmitting the e-mail to the address specified by the user. (see Fuisz col. 5, lines 19-24: route to mediating server; col. 4, lines 23-31: move sender address to other fields; col. 2, lines 38-40: transmit e-mail to address specified by user; col. 6, lines 34-37: place address of mediating server in sender field; col. 2, lines 38-40: transmit e-mail)

Regarding Claim 7, Fuisz discloses the method as in claim 6, characterized in that an identifier is added to a message retransmitted from the mediating server, a message received by the user's e-mail client program is identified to be a particular message on the bases of the identifier. (see Fuisz col. 6, lines 19-22: identifier for message)

Regarding Claim 8, Fuisz discloses the method as in claim 6, characterized in that, in the user's e-mail client program, the original e-mail address of the sender is moved from said other field into the sender field of the received e-mail message. (see Fuisz col. 6, lines 34-37: sender field, address movement)

Regarding Claim 9, Fuisz discloses the method as in claim 6, characterized in that when the user is one of the recipients of the e-mail message sent from the original sender address: in the mediating server, the addresses of the other recipients of the message to be sent further from the mediating server are replaced to other field than the address field of the message, in the user's e-mail client program, the addresses of the other recipients are extracted from said other field and shown to the user. (see Fuisz col. 5, lines 19-24: mediating server; col. 4, lines 23-31: routing information movement; col. 3, lines 59-62: routing to multiple e-mail recipients:)

Regarding Claim 10, Fuisz discloses a system for keeping user's particular e-mail correspondence separate from user's other e-mail correspondence, comprising: an e-

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mail client program in the user's computer for sending and receiving e-mails, a mediating server that retransmits e-mail messages received from the user to the message's recipient address and e-mail messages sent to the user to the user's e-mail address characterized in that the mediating server comprises: a database containing the user's e-mail address in the e-mail service that he is using and the user's address in the mediating server, means for replacing the sender address of the message received from the user with the user's address in the mediating server, and for replacing the mediating server's address in the recipient address field with the address or addresses of the original recipient(s) temporarily placed in another field or fields than address field of the message.

a) means for replacing the user's mediating server address in the receiver field of the message received to the user's mediating server address with the user's address in the e-mail service that he is using and for moving the sender address of the received message into another field of a message to be retransmitted (see Fuisz col. 5, lines 19-24: mediating server; col. 2, lines 35-40: address field replacement, move sender address), and that a plug-in program has been added to the e-mail client program, said plug-in program being adapted to: replace, in a message to be sent from the client program, the receiver's address placed in the recipient address field of the message by the user with the address of the mediating server, move, in a message to be sent from the client program, the receiver's address placed in the recipient address field of the message by the user into other field of the message than an address field, and replace, the in the message received to the client program, the

original sender address placed in said other field than the address field to the sender field of the message. (see Fuisz col. 4, lines 43-47; col. 3, lines 59-62: web user interface, plug-in capability; col. 4, lines 23-31: routing information placed in other fields; col. 7, lines 33-36: bounce system can be programmed, implementation means)

Regarding Claim 11, Fuisz discloses an e-mail mediating server in a computer network e.g. in the Internet, characterized in that the mediating server comprises: a database containing users' e-mail address in the e-mail service that they are using and the users' e-mail address in the mediating server, means for replacing the sender address of a message received from a user with the user's e-mail address in the mediating server and for replacing the address of the mediating server in the receiver address field with the address of the receiver, or that of the receivers placed in another field of the message than an address field, means for replacing the user's mediating server address in the recipient field of a message received to the mediating server with the user's e-mail address in the e-mail service he is using and for placing the sender address of the message received to the mediating server to another field of the message than an address field in the message to be retransmitted. (see Fuisz col. 5, lines 19-24: mediating server; col. 2, lines 31-35: addresses move to other fields; col. 3, lines 35-40: address extracted for e-mail processing and shown to user)

Regarding Claim 12, Fuisz discloses the e-mail mediating server as in claim 11,

characterized in that it further comprises means for placing the other recipient addresses of a message received to the user's mediating server address to another field of the message to be retransmitted than to an address field so that the user's e-mail client program can then extract these other addresses and show them to the recipient. (see Fuisz col. 2, lines 31-35; col. 4, lines 26-31: addresses move to other fields; col. 3, lines 35-40: address extracted for e-mail processing and shown to user with delivered e-mail)

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Fuisz et al.** (US Patent No. **6,389,455**) in view of **Gough et al.** (US Patent No. **6,360,221**).

Regarding Claim 4, Fuisz discloses the method as in claim 1, characterized in that replacing and moving of the address are carried out automatically in response to the pressing by the user of a particular send button. (see Fuisz col. 3, lines 59-62: user interface) Fuisz discloses a user interface, but Fuisz does not specifically disclose pressing by the user of a particular send button. However, Gough discloses wherein

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carried out automatically in response to the pressing by the user of a particular send button. (see Gough col. 5, lines 28-34: send button activation for initiation e-mail processing)

It would have been obvious to one of ordinary skill in the art to modify Fuisz as taught by Gough to enable the capability pressing by the user of a particular send button. One of ordinary skill in the art would have been motivated to employ the teachings of Gough in order to enable the capability to increase system functionality by increasing the types of e-mail processed such as enhanced e-mail. (see Gough col. 2, lines 32-37: "*... The web site preferably provides at least one process for enhancing the message with a self-executing programmable enhancement and information of an advertising nature to create an enhanced e-mail message, and for e-mailing the enhanced e-mail message to the at least one recipient mail box. ...*"; col. 2, lines 52-56: "*... Still further, the ability to push web-type content, audio and/or visual files, and programs to users in the form of self-executing e-mail programs adds a new level of functionality to the Internet. ...*")

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kyung H. Shin whose telephone number is (571) 272-3920. The examiner can normally be reached on 9:30 am - 6 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Kyung H Shin
Patent Examiner
Art Unit 2143

Kyung H. Shin
KHS
April 20, 2007